UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,305	06/23/2006	Satoshi Suda	07481.0049	8969

22852 7590 06/09/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
VASISTH, VISHAL V	

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
06/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/584,305	SUDA ET AL.	
	Examiner	Art Unit	
	VISHAL VASISTH	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 14 is objected to because of the following informalities: claim 2 reads, "C6-C16 fatty acids in the fatty acids in 0.1 – 30%," wherein the claim should read, "C6-C16 fatty acids in the fatty acids is 0.1 – 30%." Appropriate correction is required.

2. Claims 11-18 are objected to because of the following informalities: claims 11-18 depend upon claim 1 which was canceled. These claims should depend upon claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Garmier et al., US Patent No. 6,383,992 (hereinafter referred to as Garmier).

Garmier discloses a composition comprising a modified vegetable oil such as 28.66 wt% of a genetically modified sunflower oil (triester of fatty acids and glycerin as recited in claim 10 and within the range as recited in claim 11) having an oleic acid profile of 70.0 wt% (within the range as recited in claim 10), a linoleic acid profile of 7.0 wt% (within the range as recited in claim 12) and a

palmitic acid profile of 13 wt% (within the range as recited in claims 14-15) (Col. 5/L. 44-47). The composition of Garmier further comprises additives such as pour point depressants, antioxidants and additional synthetic ester base oils including mono- and diester base oils (as recited in claim 15), and/or polyalphaolefins (hydrocarbon oil as recited in claim 11) (Col. 8-9/L. 13-30).

Garmier discloses that the lubricant composition is useful in applications including hydraulic fluids amongst others. Garmier further discloses all of the limitations of the instant claims and therefore inherently could be used as a cutting/grinding/roll forming oil (as recited in claim 16) or a metal working oil (as recited in claim 17) and/or an oil for metal working with a minimal quantity lubricant system (as recited in claim 18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garmier in view of Yokota et al., US Patent Application Publication No. 2002/0035043 (hereinafter referred to as Yokota).

Garmier discloses all of the limitations discussed above. Garmier, however, does not explicitly disclose the composition being used in cutting/grinding/roll forming oil (as recited in claim 16) or a metal working oil (as recited in claim 17) and/or an oil for metal working with a minimal quantity lubricant system (as recited in claim 18) applications.

Yokota discloses a cutting or grinding oil composition (as recited in claim 16) which are suitable for use in a minimal quantity lubrication system (as recited in claim 18) (see Abstract) which can be used to lubricate a metal piece to be cut or ground (as recited in claim 17 (Para. [0001]) comprising high-oleic rape or high-oleic sunflower oil as a base oil along with auxiliary additives. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the composition of Garmier in the applications of Yokota because the compositions are fully capable of performing the functions of Yokota.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where

the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 10-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-9 of copending Application No. 12/076,978. Although the conflicting claims are not identical, they are not patentably distinct from each other. The copending application claims a composition for cutting and grinding (as recited in claim 16) comprising an ester of at least one polyhydric alcohol such as glycerin (as recited in claim 10) wherein the ester is present in an amount of at least 50 mass% (overlaps the range as recited in claim 11). The copending application further discloses additional sulfur and phosphorus additives which would have been obvious to one of ordinary skill in the art (see instant application para. [0087).

The instant application further discloses the oleic and linoleic contents of the polyhydric alcohol ester which would have been obvious in light of Garmier above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lawate et al., US Patent No. 5,538,654 (hereinafter referred to as Lawate).

Lawate discloses a lubricant composition comprising a genetically modified vegetable oil having 70 wt% of oleic acid, 13 wt% palmitic acid and 7 wt% linoleic acid content.

10. There were X references disclosed in the PCT search report that was part of the file wrapper to this application that were unused. This is because the references used were sufficient to reject the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/

Primary Examiner, Art Unit 1797

VVV